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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/025,787 | 12/26/2001 | Renato Caretta | 07040.0113 | 5883 |
| 7590 10/15/2004 Finnegan Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315 | | | EXAMINER VARGOT, MATHIEU D | |
| | | | ART UNIT 1732 | PAPER NUMBER |

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,787

Applicant(s)

CARETTA, RENATO

Examiner

Mathieu D. Vargot

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of Feeney et al (see col. 7, lines 22-41 and 59-63; col. 10, lines 39-67; col. 13, lines 41-54).

Coddington is applied for reasons of record, the primary reference failing to teach that the treatment would comprise at least one layer of a second elastomer comprising the instant polymeric base and vulcanizing system in an aqueous emulsion. However, note that at column 7, line 22, sulfur is included in composition B that is to be mixed with composition A to form the innerliner coating. This would appear to suggest that the primary reference is suggesting the use of a sulfur curable polymeric base as required in the instant claims, although it is rather clear that Coddington prefers the innerliner coating to be cured at room temperature or slightly above. At any rate, Feeney et al teaches all elements found lacking in Coddington—a clear showing of a sulfur vulcanized elastomer using dithiocarbamate accelerators (see col. 10, lines 39-57) and that the elastomer would be applied to a rubber/tire surface in whatever liquid carrier deemed suitable, be it water or solvents or a combination of the two (ie, an emulsion). See column 4, lines 18-20 and column 10, lines 59-67. As clearly pointed out by Feeney et al, the exact cure package and suitable liquid carriers for the elastomer would be “readily” designed by “one of ordinary skill in the art” (col. 10, lines 52-53) and are

Art Unit: 1732

“within the skill level of the art” (col. 10, last two lines), respectively. This is sufficient evidence to indicate that the instant claims are obvious over the applied art in that one of ordinary skill in this art would have knowledge of the instant cure packages and carriers for the elastomer and would have tailored such as desired. It would simply not be an invention to replace the solvent application and room temperature curing of the elastomer cement of Coddington with an emulsion and high temperature sulfur curing as taught in Feeney et al, given that one of ordinary skill in this art would know of the different vehicles by which a rubber would be applied in liquid form to form an innerliner on a tire.

2.Applicant's arguments with respect to claims 22-26 have been considered but are moot in view of the new ground(s) of rejection.

In view of applicant's arguments, new art has been found which fairly substantiates the previous rejection of the instant claims as obvious. While Coddington may fail to explicitly teach the instant curing and carrier agents, and indeed the previously applied Japanese Kokai -409 was not of much utility in this respect either, it is submitted that Feeney et al cures these deficiencies. Given the disclosure in the secondary reference of what is within the skill level of the art (ie, column 10, lines 52-53 and last two lines), it is fairly clear that the instant claims are obvious over the prior art.


3.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

Art Unit: 1732

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
October 14, 2004


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

10/14/04